

REMARKS

Claims 1 – 18 are pending in this application. Applicants respectfully request reconsideration in view of the following remarks.

1. THE REJECTIONS UNDER 35 U.S.C. § 103 SHOULD BE WITHDRAWN

To establish a *prima facie* case of obviousness, the prior art reference must teach or suggest all the claim limitations. *M.P.E.P. 2143*. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a suggestion found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *M.P.E.P. 2143.01*. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *Id.* Although a prior art device “may be capable of being modified to run the way [the] apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). *See also In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992), “the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or “template” to pieced [*sic*] together the teachings of the prior art so that the claimed invention is rendered obvious.”

1.1 THE CLAIMS ARE NOT OBVIOUS OVER OKIBAYASHI IN VIEW OF YOKOYAMA

Claims 1–4, 6, 8–15 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over US 5,504,599 to Okibayashi *et al.* (“Okibayashi”) in view of US 6,507,379 to

Yokoyama *et al.* (“Yokoyama”). Applicants traverse the rejection.

The combination of Okibayashi with Yokoyama does not render Applicants’ claimed subject matter obvious. The Examiner stated that “[a]t the time of the invention, it would have been obvious to one of ordinary skill in the art to use an electroluminescent layer having a red emitting layer, a blue emitting layer, and a green emitting layer that emits white light through an equal summation of the primary colors to produce bright images using a lower voltage.” However, there is no motivation found in either Okibayashi or Yokoyama to modify the teachings of Okibayashi to result in Applicant’s claimed subject matter.

Okibayashi teaches a liquid crystal display integrated with a light source. *See* Okibayashi, *e.g.*, Abstract. The light source includes a first electrode, a first insulating layer on top of the first electrode, a phosphor layer on top of the first insulating layer, a second insulating layer on top of the phosphor layer, and a second electrode on top of the second insulating layer. *See* Okibayashi, *e.g.*, col. 6, ll. 43 – 67. Okibayashi does not teach or suggest “a first electrode located on the first surface” of a light emitting element, as in Applicants’ claimed subject matter. Furthermore, Okibayashi does not teach or suggest “a second electrode located on the second surface” of a light emitting element, as in the instant claims. Rather, since Okibayashi uses a phosphor layer as the light emitting element, Okibayashi requires that the two-layer insulating structures be interspersed between the light emitting phosphor layer and each of the first and second electrodes. *See* Okibayashi, *e.g.*, col. 6, ll. 43 – 54. Therefore, Okibayashi does not teach or suggest all of the limitations of Applicants’ claims.

The Examiner contends that combining Yokoyama with Okibayashi renders Applicants’ claims obvious. However, there is no motivation found in either Okibayashi or

Yokoyama to modify the teachings of Okibayashi to result in Applicants' claimed subject matter. Yokoyama merely teaches a liquid-crystal projection device including an organic electroluminescent element consisting of successive layers of blue, green and red luminescent layers. *See* Yokoyama, *e.g.*, col. 7, ll. 40 – 44. Applicants respectfully submit that there is no motivation in either Okibayashi or Yokoyama to combine the references to derive Applicants' claimed subject matter based on the disclosure in the references. Neither has the Examiner pointed to any portion of either reference to support a motivation to combine. Rather, the Examiner appears to rely on impermissible hindsight reconstruction to piece together Applicants' claimed subject matter from the cited references. Accordingly, Applicants respectfully submit that the claims are not obvious over Okibayashi or Yokoyama, because there is no motivation found in either reference to combine their disclosures.

In view of the foregoing, the rejection of claims 1–4, 6, 8–15 and 17 under 35 U.S.C. § 103(a) as obvious over US 5,504,599 to Okibayashi *et al.* in view of US 6,507,379 to Yokoyama *et al.* should be withdrawn.

**1.2 THE CLAIMS ARE NOT OBVIOUS OVER OKIBAYASHI IN VIEW OF
YOKOYAMA AND TANG**

Claims 5 and 16 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over US 5,504,599 to Okibayashi *et al.* (“Okibayashi”) in view of US 6,507,379 to Yokoyama *et al.* (“Yokoyama”) and further in view of US 5,684,365 to Tang *et al.* (“Tang”). Applicants traverse the rejection.

The Examiner has cited Tang specifically for the alleged teaching of an “organic

electroluminescent element that has a low voltage drive, high efficiency, and low temperature fabrication (column 2 lines 41-65).” Applicants have previously pointed out that the claims are not obvious over Okibayashi in view of Yokoyama. Applicants also submit that Tang does not cure the deficiencies of Okibayashi and Yokoyama. In particular, Tang provides no motivation to modify the teachings of Okibayashi to produce the subject matter of claims 5 and 16. Accordingly, Applicants submit that claims 5 and 16 are not obvious over Okibayashi in view of Yokoyama and Tang.

In view of the foregoing, the rejection of claims 5 and 16 under 35 U.S.C. § 103(a) as obvious over US 5,504,599 to Okibayashi *et al.* in view of US 6,507,379 to Yokoyama *et al.* and further in view of US 5,684,365 to Tang *et al.* should be withdrawn.

**1.3 THE CLAIMS ARE NOT OBVIOUS OVER OKIBAYASHI IN VIEW OF
YOKOYAMA AND YAMAZAKI**

Claims 7 and 18 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over US 5,504,599 to Okibayashi *et al.* (“Okibayashi”) in view of US 6,507,379 to Yokoyama *et al.* (“Yokoyama”) and further in view of US 6,830,494 to Yamazaki *et al.* (“Yamazaki”). Applicants traverse the rejection.

The claims are not obvious over Okibayashi in view of Yokoyama and Yamazaki. The Examiner has cited Yamazaki because Yamazaki allegedly teaches a “passivation layer between an EL layer and a TFT substrate to protect the TFT substrate from alkali metals and moisture.” Applicants have previously pointed out that the claims are not obvious over Okibayashi in view of Yokoyama. Applicants also submit that Yamazaki does not cure the

deficiencies of Okibayashi and Yokoyama already described above. Yamazaki merely teaches a layering structure of an EL device, which includes insulating films containing silicon (such as silicon nitride oxide). *See Yamazaki, e.g., col. 8, ll. 38 –42.* Furthermore, Yamazaki provides no motivation to modify the teachings of Okibayashi to derive Applicants' claimed subject matter. Accordingly, Applicants submit that claims 7 and 18 are not obvious over Okibayashi in view of Yokoyama and Yamazaki.

In view of the foregoing, the rejection of claims 7 and 18 under 35 U.S.C. § 103(a) as obvious over US 5,504,599 to Okibayashi *et al.* in view of US 6,507,379 to Yokoyama *et al.* and further in view of US 6,830,494 to Yamazaki *et al.* should be withdrawn.

2. PREMATURE FINAL OFFICE ACTION

The Office Action states that the "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, THIS ACTION IS MADE FINAL." Applicants respectfully request that the Examiner reconsider the finality of the rejections. Applicants respectfully point out that the new prior art references that the Examiner has brought to Applicants' attention with this Final Office Action could properly have been cited in the first Office Action based on the language of the originally filed claims. Therefore, the new grounds for rejection were not necessitated by Applicants' Amendment filed on July 5, 2005. Accordingly, Applicants respectfully request that the finality of the Office Action be withdrawn. Otherwise, Applicants will be deprived the opportunity to properly address the newly leveled grounds for rejection.

CONCLUSION

Applicants respectfully request entry of the foregoing remarks into the file of the application. Applicants believe that each ground for rejection has been successfully overcome or obviated, and that all pending claims are in condition for allowance. Withdrawal of the Examiner's rejections, and allowance of the application, are respectfully requested.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 5000-5112. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

In the event that an extension of time is required, the Commissioner is requested to grant a petition for that extension of time to make this response timely, and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 5000-5112. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: September 9, 2005

By:



Steven F. Meyer
Registration No. 35,613

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
3 World Financial Center
New York, NY 10281-2101
(212) 415-8700 Telephone
(212) 415-8701 Facsimile